

REMARKS

This responds to the Office Action mailed on December 11, 2006.

Claims 1, 11, 20, and 21 are amended, no claims are canceled, and no claims are added; as a result, claims 1-21 are now pending in this application.

Telephonic Interview

Applicant's Attorney, David D'Zurilla, expresses his gratitude to Examiner Fenstermacher for the telephonic interview on January 4, 2007. Examiner Fenstermacher and Mr. D'Zurilla discussed the claimed subject matter and U.S. Patent No. 4,062,156 to Roth. No agreement regarding the claimed subject matter was reached during the interview.

Examiner Fenstermacher requested that the Applicant consider U.S. Patent No. 6,026,970 to Sturm et al., and in particular, FIG. 5, Nos. 24 and 26. The Examiner also requested that the Applicant consider the other cited art of record.

Regarding Sturm et al., Nos. 24 and 26 are linear bearing tracks and linear bearings respectively. (Col. 2, lines 50-54). This bearing structure is more clearly illustrated in FIG. 1. The Applicant respectfully submits that this bearing structure is not the interference stops that tangentially contact each other as recited in the pending claims.

The Applicant has reviewed all the U.S. patents cited in Office Action, and did not find in any of these U.S. patents the interference stops that tangentially contact each other as recited in the pending claims.

§112 Rejection of the Claims

The Office Action rejected claims 1-21 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

The Applicant respectfully traverses this rejection. However, in order to advance the prosecution of this application, the Applicant has amended claims 1, 11, 20, and 21. The Applicant has removed the descriptor "tangential" from the interference stop feature elements, and has further recited that such features are "radially attached" to a lead screw or a tubular

screw as the case may be. The foregoing amendment was made to more particularly point out the claimed invention, and not to alter the scope of the claimed invention.

The Applicant respectfully submits that these amendments overcome the rejection of the claims under 35 U.S.C. § 112, second paragraph, and further respectfully requests that this rejection be withdrawn.

§102 Rejection of the Claims

The Office Action rejected claims 1-4, 7-14, and 17-21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,062,156 to Roth. The Applicant respectfully traverses this rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (*emphasis added*). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131.

Claim 1 recites that the “lead interference stop feature tangentially contacts said first interference stop feature.” The written description discloses that a tangential contact is a simple non-frictional surface to surface contact between a transverse face of a lead interference stop feature and a transverse face of a first interference stop feature. The written description further explains that the transverse faces are parallel to the axis of rotation of the actuator. (See ¶ 18).

The ‘156 patent to Roth by contrast refers to an extensible rod which does not disclose such a tangential contact. FIG. 1 of Roth illustrates an abutment ring 23. The ring 23 completely surrounds the tube to which it is attached as indicated by the phantom lines in FIG. 1. Since the abutment element of Roth is a ring, there are no exposed transverse faces (*i.e.*, surfaces

that are parallel to the axis of rotation), and it is therefore not possible for the ring of Roth to tangentially contact another tube or a portion of another tube.

Furthermore, FIG. 2 of Roth illustrates that the abutment ring that is attached to tube 13 (not numbered in FIG. 2, but flange 24 is numbered) contacts a shoulder of tube 12 on a non-tangential surface.

Since the abutment ring of Roth has no exposed transverse surfaces, it cannot engage in a tangential contact. Consequently, the Applicant respectfully submits that the rejection of claim 1 is in error, and further respectfully requests the withdrawal of this rejection. Furthermore, since claims 2-10 depend either directly or indirectly on claim 1, claims 2-10 also contain the “tangentially contacts” element, and the Applicant respectfully submits that the rejection of these claims is in error, and further respectfully requests the withdrawal of the rejection of claims 2-10.

The remaining claims, claims 11-21, all contain the “tangentially contacts” element. Therefore, as with claims 1-10, the Applicant respectfully submits that the rejection of these claims under 35 U.S.C. § 102(b) is in error, and further respectfully requests the withdrawal of the rejection of claims 11-21.

§103 Rejection of the Claims

The Office Action rejected claims 5-6 and 15-16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,062, 156 to Roth. The Applicant respectfully traverses this rejection.

The Patent Office bears the initial burden of factually supporting a *prima facie* case of obviousness.¹ In order for the Office Action to establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

¹ MPEP 2142.

reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.²

As pointed out above, the Roth patent fails to disclose the "tangentially contacts" feature of the claimed invention in the instant application. Roth therefore fails to teach or suggest all the claim limitations. The Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness, and further respectfully requests the withdrawal of the rejection of claims 5-6 and 15-16.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at 612-371-2140 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or

² MPEP § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

Respectfully submitted,

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Date January 16, 2007 By David D'Zurilla

Reg. No. 36,716

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of January 2007.

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